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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,803	10/29/2003	Shunpei Yamazaki	0756-7214	6055

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EXAMINER

DANG, TRUNG Q

ART UNIT	PAPER NUMBER
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2823

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

51

Office Action Summary	Application No.		Applicant(s)	
	10/694,803		YAMAZAKI ET AL.	
	Examiner		Art Unit	
	Trung Dang		2823	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/9/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6-38 are rejected under 35 U.S.C. 103(a) as being obvious over Takayama et al. (US 2003/0032210 of record, hereinafter Takayama' 210) in view of Takayama et al (US 2004/0087110, hereinafter Takayama' 110).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the

application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

With reference to Figs. 4A-4C and Figs. 5A-5C, the Takayama' 210 teaches the a method of manufacturing a semiconductor device, comprising:

forming a metal layer **41** in contact with a substrate **40**;

forming an oxide layer **42** in contact with the metal layer, and a layer **43** to be peeled including a semiconductor element over the oxide layer (Fig. 4A and Embodiment 3 in conjunction with Embodiment 1);

bonding a support to the layer to be peeled (paras. [0141], [0144], [0170] and claims 13, 17);

irradiating the metal layer **41** with a laser beam (para. [0167]-[0168]);

peeling the layer **43** to be peeled that is bonded to the support from the substrate with a physical means at an interface between the oxide layer **42** and the metal layer **41** (Fig. 4B and para. [0169]-[0170]).

Note that, although the reference is silent about the oxidation of the metal layer **41** to form a metal oxide layer between the metal layer **41** and the oxide layer **42**, such is inherently occurred because of the following reasons: a) the material of metal layer **41** and that of disclosed in the pending application are identical, and b) the type of laser beam used are also identical, hence the result produced by two identical

processes must be the same. Despite the above inherency, it is known that when the oxide layer **42** is formed on the metal layer **41**, the surface of the metal layer is oxidized (see para. [0015] in US 2004/0087110 that is cited merely for the purpose of showing this fact), thus a metal oxide is inherently present at the interface between the metal layer **41** and the oxide layer **42**. Furthermore, claim 17 of the reference indicates that the oxidizing step, which is inherently resulted by the laser irradiation, is performed after bonding the support substrate to the layer 43 to be peeled.

Takayama' 210 differs from the claims in not disclosing the step of removing a portion of the metal layer 41 which is in contact with a peripheral portion of the substrate.

However, in the same field of endeavor, Takayama' 110 teaches that when a metal layer is formed on a substrate by sputtering, a thickness in the vicinity of a peripheral portion of the substrate is likely to be ununiform since the substrate is fixed by sputtering. Therefore, it is preferable that only the peripheral portion is removed by conducting dry etching (paras. [0068], [0069]).

It would have been obvious to one of ordinary skill in the art to modify the teaching of Takayama' 210 by removing a portion of metal layer 41 which is in contact with the peripheral portion of the substrate as suggested by Takayama' 110 because such removal step would ensure the thickness of the metal layer 41 to be uniform on the entire surface of the substrate, hence facilitates the peeling because the thickness of the metal oxide (oxidized metal 41) is uniform.

For claim 7, see para. [0154] for the limitation regarding an insulator layer is provided between the substrate **40** and the metal layer **41**.

For claims 11-26, see paragraphs [0139], [0144] for the materials of the metal layer 41, the substrate, and the support substrate.

For claims 27-31, the Embodiment 4 illustrated in Figs. 5A-5C teaches every limitation of the claims, wherein the zinc oxide (ZnO) **52a** reads on the claimed metal oxide. That is, the ZnO **52a** is formed between metal layer **51** and oxide layer **52b** (see Fig. 5A).

For claim 34, see para. [0167] for the type of laser.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 6-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 10/193,912 (Takayama' 210 reference noted above) in view of Takayama's 110 as above and Shimoda et al. (US 6,372,608 of record).

This is a provisional obviousness-type double patenting rejection.

Claim 17 of the US' 912 when read into its base claim 13 comprises a step of irradiating a laser beam onto a laminated structure comprising a metal layer over a substrate, an oxide layer in contact with the metal layer, a peeled off layer on the oxide layer, and a support layer adhered (i.e. bonded) to the peel off layer.

Claim 17 differs from the pending claims 6, 7, 8, and 27 in the step of removing a portion of the metal layer which is in contact with a peripheral portion of the substrate.

However, in the same field of endeavor, Takayama' 110 teaches that when a metal layer is formed on a substrate by sputtering, a thickness in the vicinity of a peripheral portion of the substrate is likely to be ununiform since the substrate is fixed by sputtering. Therefore, it is preferable that only the peripheral portion is removed by conducting dry etching (paras. [0068], [0069]).

It would have been obvious to one of ordinary skill in the art to modify the teaching of claim 17 by removing a portion of metal layer which is in contact with the peripheral portion of the substrate as suggested by Takayama' 110 because such removal step would ensure the thickness of the metal layer to be uniform on the entire

surface of the substrate, hence facilitates the peeling because the thickness of the metal oxide (oxidized metal) is uniform.

The modified claim 17 noted above is now different from the pending claims 6, 7, 8, and 27 in the presence of a metal oxide layer between the metal layer and the oxide layer. However, the metal oxide layer is inherently formed at the interface between the metal layer and the oxide layer when the laminated structure is irradiated with a laser beam or when the oxide layer is formed on the metal layer for the same reasons noted in the above 103(a) rejection. Furthermore, with respect to the claimed limitation regarding the oxidizing step that is performed after bonding the support to the layer to be peeled, claim 17 of the US' 912 indicates that the oxidizing step, which is inherently resulted by the laser irradiation, is performed after bonding the support substrate to the layer 43 to be peeled.

For pending claims regarding the materials of the metal layer, claim 15 of the US' 912 recites metal elements as claimed. Thus, the selection of such metal elements for the metal layer of claim 13 would have been obvious to one of ordinary skill in the art because the use of known materials for the same purpose would have been within the level of one skill in the art.

For pending claims regarding the materials of the substrate and the support layer, Shimoda teaches a peeling method in which a substrate is made of glass or quartz (col. 11, lines 17-25) and a support layer 6 (Fig. 4) is made of plastic or plastic base materials (col. 15, lines 17-15). It would have been obvious to one of ordinary

skill in the art to select the materials for the substrate and the support layer of claim 13 as suggested by Shimoda because such materials are conventionally used in the art of transferring thin film devices from a substrate onto a transfer member, and the employment of known materials for the same purposes would have been within the level of one skilled in the art.

Response to Arguments

4. Applicant's arguments with respect to claims 6, 7, 8, and 27 have been considered but are moot in view of the new ground(s) of rejection.
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trung Dang whose telephone number is 571-272-1857. The examiner can normally be reached on Mon-Friday 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Smith can be reached on 571-272-1907. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2823

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Trung Dang
Primary Examiner
Art Unit 2823

05/01/06